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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
RUHL, DENNIS WILLIAM	
ART UNIT	**PAPER NUMBER**
3629	

DATE MAILED: 11/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/003,738	SCHAER ET AL.	
	Examiner	Art Unit	
	Dennis Ruhl	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *18 August 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3-11 and 15-27* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3-11,15-27* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Applicant's response of 8/18/05 has been entered.

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1,3-11,21-27, rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

For claim 3, applicant has claimed the means for assigning as comprising a "means for converting said output response into ....encrypted user weight indicator". It is not clear what the scope of the converting means is. From the specification it is disclosed that the means for assigning the weight ranges to encrypted weight indicators is a chart. What then is the converting means and how does it differ from the means for assigning? It seems to the examiner that they are one and the same thing. Upon consulting the specification for guidance on the scope of the recited means plus function it is not clear what the difference is between the means for assigning and the converting means. This renders the scope of the claim indefinite.

For claims 1,21,26, the claims are considered indefinite because the examiner does not know what the scope is. This is because applicant has claimed that the scale does not have a public display that indicates the user weight in terms of numerical mass. Applicant is reciting a negative limitation, which is permissible depending on what specific language is used; however, in this case it is not clear what the negative limitation means as far as the claim scope goes. Does the language about not having a

public display allow for a private display that displays the weight in numbers of pounds? The examiner is not clear as to what the negative limitation means as far as structure goes. What is the difference between a public display and a private display? Applicant has recited what the scale does not have, but what does this claim about what the scale does have? The examiner also questions whether or not one wishing to avoid infringement would understand the scope of the claim. If one were to use a scale in private like in the privacy on their home, would the claim be infringed, even if structurally the system were the same otherwise? The examiner is having trouble understanding the word "public" in the claim because the patentability of the system should depend on structure of the system itself and should not depend on whether or not the display is public or private.

For claim 18, it is not clear to the examiner how applicant can claim that if none of the encrypted weight indicators correspond to the assessed weight, when claim 15 states that there are weight ranges created for anticipated weights of skiers. Claim 15 already sets forth that the weight ranges do have associated encrypted weight indicators so the scope of the claim becomes unclear when applicant claims that none of the encrypted weight indicators may apply.

For claim 26, the preamble of the claim recites that the method is for selecting a ski for a user. The examiner notes that there is no actual step in the body of the claims that recites a selection of a ski. This renders the claim indefinite because it is not clear whether or not the step of selecting a ski is required in the claim or not. If you claim a method of selecting a ski, you must have a step that selects a ski.

For claim 23, there is no antecedent basis for "the indicator face". None has previously been claimed and it is not clear as to what this refers to.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1,5,6,9, are rejected under 35 U.S.C. 102(b) as being anticipated by Yucca Dune's ski sizing chart that was online and available to the public as of April 1999.

For claims 1,5,6,9, Yucca Dune is a web site that allows one to order skis online. The ski-sizing chart anticipates what has been claimed. The instant specification in the last paragraph of page 6 to page 7 states "*Thus, the reference chart provides both the means for accessing the unannounced weight of the user and the means for assigning the weight into one of the predefined weight ranges to…. for providing an encrypted user weight indicator*". The ski sizing chart sets forth weight ranges for users and correlates the weight to an encrypted weight indicator, which is the ski length in centimeters. The recited ski indicia are the ski lengths that are found on the skis so you know what the length of the ski is. The ski-sizing chart allows one to select skis as claimed.

5. Claims 21-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Terraillon (3910366).

For claim 21, Terraillon discloses a bathroom scale that is used in a person's bathroom. The scale has a mechanism to obtain a weight reading, that is what a scale is by definition. A bathroom in one's home is a private place so when the scale is used in a person's bathroom, any display of weight is not public. The indicator is shown in figure 1 and communicates a range of weights to the user. If one weights 100 pounds, a range of numbers is visible to the user of the scale and this satisfies what is claimed. With respect to claiming that the range on the scale is coordinated to ski indicia, because it is well known in the art that skis are chosen based on weight (by a weight ski size chart), this satisfies what is claimed.

For claim 22, the pointer is 3 and the face is 1 (the dial with indicia). The face has ranges as claimed, which are the lines that represent 1-pound increments. The ranges correspond to ski indicia because skis are matched to skiers by weight.

For claim 23, ranges in the form of numbers are on the face as claimed. The different weights relate to different skis. If you weight 75 pounds versus 180, your correct sized ski will be different. Different weights correspond to different sized skis.

For claim 24, the claimed intermediate zone is the area between lines on the face. In the range of 30-40 pounds, there are 10 intermediate zones to be found.

For claim 25, the plurality of symbols are the numbers themselves. Numbers are symbols because they are a textual representation of how many of something there is.

The language claiming that the symbols are coordinated to differing skis is satisfied because different weights correspond to different sized skis.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 15-20,26,27, are rejected under 35 U.S.C. 103(a) as being unpatentable over Yucca Dune's ski sizing chart that was online and available to the public as of April 1999.

For claims 15,16,26, Yucca Dune discloses a web site that allows one to order skis online. It is disclosed and shown in the chart that a set of user weight ranges is defined. Also in the chart is a set of encrypted weight indicators that correspond to the weight ranges. The encrypted weight indicator is the ski length appropriate for the

associated weight range. Because Yucca is in the business of selling skis, which is why they have a sizing chart that a customer can use to pick their correct size, it is considered inherent that a collection of skis is being provided. The collection of skis that are sorted into groups are the different ski lengths available for purchase, with each length defining a group. The examiner considers it inherent that the skis also have the ski length (encrypted indicator) as indicia because that is how one knows what ski to send to the purchaser. Not disclosed is that the weight of the user is assessed without providing a public disclosure of the weight in terms of numbers and then a chart is used to ascertain what encrypted weight indicator corresponds to the weight range their weight falls into, so that they can select a pair of skis. Because Yucca Dune is a web site that allows a person to purchase skis online, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have the user weigh themselves at home so that they know their weight accurately. This satisfies the claimed assessing of the weight without publicly providing a numeric indicator of the weight. The assessing of the weight at a person's home is private and not public. Once the weight is known one of ordinary skill in the art would find it obvious to use the ski sizing chart to find the weight range that their weight falls into so they can then select the correct ski length (identification of the encrypted weight indicator). After all, that is the reason that the ski-sizing chart has been provided, so that the user can choose the correct sized ski.

For claim 18, because the chart sets forth that for the weight range of 60-90 pounds an encrypted weight indicator of 150 is desired. The indicator of 150 also

applies to the sub-range of 70-80 pounds. This satisfies what has been claimed. The indicator for the range of 60-90 also applies to the sub range of 70-80. Because claim 18 includes in its scope the situation where one of the encrypted weight indicators does correspond to the assessed user weight, Yucca satisfies what has been claimed. If one of the encrypted weight indicators applies to user weight, the providing of a query is not present and not required.

For claims 17,20,26, a scale is a weighing station. In the event that the person has a weight of 175 pounds, according to the Yucca ski-sizing chart, this corresponds to a size 175cm ski. When a person who weighs 175 pounds is weighed on a scale, the scale is displaying the encrypted weight indicator as claimed because the correct sized ski for that weight is 175cm. This also is true for a 190-pound skier, the scale would read 190 and the chart shows that the encrypted weight indicator is 190 (cm).

For claim 19, Yucca satisfies what is claimed because a reference chart is being used to choose the correct sized ski. The user weights themselves, which is providing a known weight, then the chart is referenced as claimed.

For claim 27, not disclosed is that the scale has a face with a pointer and zones on the face. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use a scale that has a face with a dial and a pointer as is very old and well known in the art. Most common bathroom scales are of the type that have dials and rotating faces that rotate to the weight value. Each dial has numbers and markings that constitute zones as claimed. In the area of 175 pounds, indicia of 175 is found that matches a sized 175cm ski. This satisfies what has been claimed.

9. Claims 1,3-11,15,16, are rejected under 35 U.S.C. 103(a) as being unpatentable over Kantar et al. (4164875) in view of Schneider (5123494).

For claims 1,5,9,11,15,16, Kantar discloses a system to aid a user in the selection of a ski. The mechanism for assessing the weight of the user is the scale 30. The means for providing an encrypted weight indicator based on the weight is the chart 80 that correlates user weight to ski length so that the correct size ski can be chosen (the ski inherently has the ski length as indicia as is notoriously old and well known in the art). Not disclosed is that the mechanism for assessing the user weight does not publicly disclose the weight in terms of numeric units and that the user weight on the chart is divided up into ranges. With respect to the chart and having weight ranges, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use ranges for the weights. This is considered obvious because the alternative to using weight ranges is to have each weight listed individually and this would result in pages and pages of weights. One of ordinary skill in the art would appreciate and find obvious the use of ranges for the weights so that one would not have to list weights individually, which would be cumbersome and would require a list of enormous length. Schneider discloses a system that helps prevent theft in a retail environment. A customer is weighed as they enter a store and they are weighed again when they leave to compare an entering weight to a leaving weight. If the weights disagree by a certain amount, this may indicate theft. In column 3, lines 15-25 it is disclosed that the taking of a person's weight may be taken as an invasion of their privacy so it is preferable that the weight be encoded so somebody cannot detect what your weight is and your weight

can be kept private. This is a teaching of the fact that a person's weight can be a sensitive issue and is not something that should be publicly known. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kantar by taking the skier weight in a private manner so that their weight is not publicly displayed. One of ordinary skill in the art would be motivated to keep the weight private and this could be done by providing a private room for the weighing of the skier or simply by ensuring that the display that shows skier weight is not in view of the public.

For claim 3, the scale has a platform that the user can stand on as shown in Figure 1. A scale by definition has a means for providing an output response that is proportional to the load applied to the platform. Once the weight is known, the user can refer to the chart 80 to convert their weight to the encrypted weight indicator. The means for converting the output response (just a number) is the chart 80.

For claim 4, applicant is claiming an input device for the user to input their weight so that a processor can then correlate the weight to an encrypted weight indicator. The examiner interprets the scale to be the user input interface because when one stands on the scale, this is the providing of an input as claimed. Applicant is essentially reciting the automating of the manual process of looking up the weight on the chart 80 and finding the associated encrypted weight indicator. Applicant is just reciting that the process of referring to the chart is automated so that a person does not have to do it. It would have been obvious to one of ordinary skill in the art at the time the invention was made to automate the manual activity of referring to the chart to correlate the skier weight to the encrypted weight indicator by using a computer processor (data

processing unit) that takes the weight from the scale and determines the encrypted weight indicator. It has been previously held that the mere automation of an activity that is recognized in the prior art as being done manually is not sufficient to distinguish over the prior art (In re Venner, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958)).

For claims 6,7, not disclosed is how many weight ranges there are. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide 4 weight ranges so that you do not need to list 100 weight ranges. The choice of how many ranges should be used on the chart is a choice that one of ordinary skill in the art would find obvious. One could have 10 weight ranges if they want to.

For claims 8,10, applicant has claimed that the encrypted weight indicators and the matching ski indicia share a distinct color. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the text of the chart 80 and the indicia on the ski both be the color black because the use of black as a color for printed text is very well known. Simply having the text on the chart be black (the most common color for printed matter) and the indicia on the skis be black satisfies what is claimed.

10. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Ruhl whose telephone number is 571-272-6808. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DENNIS RUHL
PRIMARY EXAMINER